REMARKS

The above amendments and following remarks are submitted in response to the pending Official Action of the Examiner mailed June 6, 2008. Having addressed all objections and grounds of rejection, claims 1-21, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

Claims 11-15 and 16-20 have been rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. In response thereto, claims 11 and 16 have been amended as suggested by the Examiner. Even though Applicants have herewith amended claims 11 and 16 have been amended to more expeditiously advance the prosecution of the subject application, it is respectfully suggested that the Examiner consult 35 U.S.C. 112, paragraph 6, and MPEP 2181-2184, with regard to the form of originally presented claim 11 and consult 37 C.F.R. 1.75(e) with regard to the format of originally presented claim 16.

Claims 11-15 and 16-20 have been rejected under 35 U.S.C. 112, second paragraph, using the same flawed legal reasoning used to support the rejection of these claims under 35 U.S.C. 101. As explained above, claims 11 and 16 have been amended as suggested by the Examiner to expedite the prosecution of the subject application.

Claims 1 and 6-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,012,090, issued to Chung et al (hereinafter referred to as "Chung") in view of U.S. Patent No. 5,379,432, issued to Orton et al (hereinafter referred to as "Orton") and further in view of newly applied U.S. Patent No. 5,822,621, issued to Gartner et al. (hereinafter referred to as "Gartner"). This ground of rejection is respectfully traversed for failure of the Examiner to provide any of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1)motivation to make the alleged combination; 2)reasonable likelihood of success of the alleged combination; and 3)all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

In an apparent attempt to make the first required showing of "motivation" to combine Orton and Gartner with Chung, the Examiner states:

> iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention[1] of Chung with the teaching of Orton and Gartner for enabling the application to access in an object-orient manner, services provided by the operating system **(column 3, lines 59-61 of Orton)**.

The actual sentence of Orton (i.e., column 3, lines 58-61) reads:

> The object-oriented class library comprises related object-oriented classes for enabling the application to access in an object-oriented manner services provided by the operating system.

Thus, even though Orton alleges that its "object-oriented classes" can enable its own application to access its own services provided by its own operating system in an object-oriented manner, there is no showing that it would enable an application of Chung to access a service of Chung provided by the operating system of Chung in the alleged object-oriented manner.

Similarly, there is no showing that Gartner discloses a system having the claimed object-oriented environment. As a result, there can be no more motivation for the alleged combination with newly cited Gartner than with the previously cited Chung.

In fact, those of skill in the art would readily recognize that if Chung and/or Gartner did not provide an object-oriented environment, the advantages alleged by the Examiner could not be

---

[1] As a matter of law, the "invention" of Chung is defined by the claims of Chung. It would appear that the "invention" of Chung is not particularly relevant to the Examiner's argument, because he does not cite the claims of Chung to support his rejection. Perhaps, the Examiner means "to have modified" the "disclosure" of Chung.

provided by the alleged combination. Conversely, if Chung and/or Gartner did have an object-oriented environment (which is not disclosed by either reference), there would be no advantage to make the alleged combination with Orton. Therefore, the Examiner has not and cannot make the required showing of motivation.

The Examiner simply ignores her obligation to show reasonable likelihood of success. Because of the readily apparent incompatibilities amongst Chung, Orton, and Gartner, it is highly unlikely that the Examiner could have made this showing, even if she had tried.

The third required showing is that the alleged combination has all of the claimed elements. This cannot be accomplished, because of the differences in architecture, purpose, and functionality of Applicant's invention from that of Chung, Orton, and Gartner or the alleged combination thereof.

Applicant's invention as disclosed and claimed provides an apparatus for and method of improving the efficiency of service request/response activity requiring security functions. A security facility, such as Security Support Provider Interface is embedded in a communication class library which controls the communication between client and server applications. A context token is associated with the service request which specifies the security functions to be provided in honoring that particular request without any particular attention by ether client or

server application, as the security functions are exclusively concerned with the communication process rather than the service request/response activity.

In other words, the security facility is embedded and largely transparent to both user and service application because it is not used to regulate access by the user, but it is used to simply control the security over the communication link (e.g., Internet) between the user and the service.

This is readily distinguishable from Chung which utilizes a user generated password (see column 11, lines 22-28) to register user access to a service, and Orton which operates in a single computer (see Fig. 1) and addresses only similar access registration (see column 20, lines 24-43). Thus, neither Chung nor Orton nor the combination thereof has the claimed limitations, because Chung only addresses user registration and Orton, operating in a single computer, does not even have the communication issues associated with Applicant's invention. However, these distinctions are best viewed by separate analysis of each of the pending claims. Again, Gartner does not explicitly disclose security functionality.

Claim 1 is an independent apparatus claim having five basic limiting elements. The third element is "a communication class library which regulates communications between said client

application and said service application". The Examiner clearly erroneously alleges:

> a communication class library which regulates communication between said client application and said service application (**see Figure 1 of Chung**).

However, she quickly contradicts herself stating:

> .....Chung is silent on the capability of using a communication class library which regulates communication between said client application and said service application.

As a matter of fact, Chung does not have the third claim limitation as freely admitted by the Examiner.

In an apparent attempt to show the claimed element, the Examiner further states:

> On the other hand, Orton teaches this limitation in column 4, lines 16-20 of Orton, and Gartner teaches this limitation in column 5, lines 15-20 of Gartner.

This statement is both clearly erroneous and unsupported by the prior art of record. Column 4, lines 16-20, of Orton actually says:

> (4) **interprocess** communication (IPC) classes for enabling an application to access in an object-oriented manner operating system services to communicate with other threads during run-time execution of the application **in a computer**. (Emphasis added)

In view of the only disclosed embodiment of Orton being within a single computer (see Fig. 1), the IPC involves only communication within a single process (i.e., "**interprocess**") and occurs within the single computer disclosed by Orton. Thus, the IPC of Orton cannot possibly meet the limitations of the third claimed element

which require regulates communication between different computers (see claim elements a and b).

Having previously made this argument with regard to Orton and apparently in view of Applicants' response thereto, the Examiner has now cited Gartner, column 4, lines 15-20, as if it somehow were pertinent to Applicants' claimed invention. The citation actually states:

> In the preferred embodiment of the invention, a distributed class library containing the address and naming services and policy requirement information for all middle-ware associated with clients and servers in the distributed system forms the framework. This class library includes the data that provide the "register" of the address and naming service and the policy information for the framework.

Thus, because Gartner does not have the claimed "**communication** class library", the cited class library of Gartner does not "regulate communication between" the claimed "client application" and the claimed "service application".

The fourth claimed element is "a security facility embedded within said communication class library". Because the alleged combination does not have the claimed "communication class library", it cannot possibly have the fourth claimed element. Furthermore, there is no showing that even if the alleged combination did have the claimed "communication class library", there is no showing of a "security facility" embedded therein.

Therefore, the Examiner clearly erroneously makes three legally irrelevant citations to Chung which admittedly does not

have the claimed "communication class library". It cannot possibly have the claimed "security facility" embedded into a "communication class library" which it does not have.

The fifth claimed element further limits the claimed "security facility" by requiring "wherein said security facility is automatically activated by said service request". Because the alleged combination has no such security facility as claimed, it cannot have this further limitation. In addition, the security provisions disclosed by Chung relate to user registration which must of necessity involve manual operation of the user rather than the claimed "automatically activated" functions.

Having not shown motivation, reasonable likelihood of success, or all claimed elements within the alleged combination as required by MPEP 2143, the Examiner has not presented a *prima facie* case of obviousness. Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 6 is an independent method claim having six steps as limiting elements. The first step is "embedding a security facility within a communication class library". The Examiner freely admits that Chung does not have the claimed "communication class library". As explained above, neither Orton nor Gartner has the claimed "communication class library" because only a single computer is disclosed by Orton and Gartner discloses no security provisions. Therefore, the alleged combination cannot

possibly meet the limitations of the first claimed element. Furthermore, even if Chung did disclose the claimed "security facility" (which it does not) and Orton and/or Gartner disclosed the claimed "communication class library" (which they do not), the Examiner cannot show any suggestion in the record (other than Applicant's claimed invention) for "embedding" the one element in the other as is explicitly claimed.

The fifth claimed step is "honoring said service request by said service application". The alleged combination does not disclose this step. Therefore, the Examiner cites Chung, column 4, lines 25-29, which states:

> The requested network service may be designated by a uniform resource locator (URL), which includes a domain name identifying the server 14 or a corresponding server cluster hosting the service.

Clearly, this citation says nothing of the claimed "honoring" step. It is not understood why one would consider this pertinent to Applicant's claimed fifth step.

The sixth claimed step is "automatically implementing security functions from said embedded security facility during said step which honors said service request". As shown above, the alleged combination does not disclose the claimed "honoring" step, and the alleged combination does not have the claimed "embedded security facility". Furthermore, the alleged combination does not have the claimed "automatically implementing" step, because its security activities are limited

to manual user registration. Therefore, the Examiner makes three citations to Chung which are legally irrelevant, because they do not address Applicant's claimed invention.

The Examiner has made none of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness. Therefore, the rejection of claim 6, and all claims depending therefrom is respectfully traversed.

Claim 7 depends from claim 6 and is further limited by "a context token transferred from said client to said service application identifying required security functions from said embedded security facility". The alleged combination does not disclose the claimed "context token". Therefore, the Examiner cites Orton, column 20, lines 24-44, which is legally irrelevant, because it does not address Applicant's claimed invention. Though the citation parenthetically mentions a "security token", it is clearly not transferred from one computer to another as required by the claim (see also claim 6), because Orton discloses only a single computer. Furthermore, the alleged combination does not have the claimed "embedded security facility". The rejection of claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and is further limited by "wherein said transferring step further comprises transferring said service request to said service application via a publically accessible digital data communication network". As explained

above, the alleged combination does not disclose the limitations of claim 7 from which claim 8 depends. Therefore, the alleged combination cannot disclose the further limitations of claim 8. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by "wherein said client application is located within said user terminal". As explained above, the alleged combination does not disclose the limitations of claim 8 from which claim 9 depends. Therefore, the alleged combination cannot disclose the further limitations of claim 9. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and is further limited by "a data base management system wherein said service application is located within said data base management system". The alleged combination does not disclose a "data base management system" as claimed. Therefore, the Examiner cites Chung, Fig. 1, which is legally irrelevant, because it does not address Applicant's claimed invention. The rejection of claim 10 is respectfully traversed.

The Examiner has apparently refused to examine claims 11-20 as required by law. In doing so, she has stated:

> g. *Referring to claims 11-20*
> I. These claims have limitations that are similar to those of claims 6-10, thus they are rejected with the same rationale applied against claim 12 (sic) above.

This statement appears to be a refusal to examine claims 11-20. In alleging that these claims "are rejected with the same rationale applied against claim 12", the Examiner explicitly admits that she has not examined claimed 11-20, because she has not examined claim 12.

Furthermore, the allegation that "these claims have limitations that are similar" appears to create a new standard which is not supported in controlling law. Perhaps most significant is that claims 11-20 have standards of patentability which are different as a matter of law. For example, claims 11-15 employ "means-plus-function" limitations which must be examined under MPEP 2181-2184. The Examiner has not done so.

Thus, the rejection of claims 11-20 is respectfully traversed for failure of the Examiner to actually examine the claims.

Claims 2-5 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Orton and further in view of Gartner and further in view of U.S. Patent No. 6,341,353, issued to Herman et al (hereinafter referred to as "Herman"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as defined by MPEP 2143.

To the untenable alleged combination of Chung, Orton, and Gartner, the Examiner alleges the further combination with

Herman. In an apparent attempt to show motivation for this further combination, the Examiner states:

> iv. The ordinary skilled person would have been motivated to:
>
> (1) have modified the modified-invention[2] of Chung with the teaching of Herman so that two parties who do not trust each other can each determine that the other entity is who it claims to be. This is accomplished with authenticating protocols that may employ encryption, hashing, digital signatures, etc. (**column 18, lines 41-44 of Herman**).

Again, the Examiner's showing of motivation is largely incomprehensible. However, to the extent that it is understood, it is clear that the Examiner's citation of Herman (i.e., column 18, lines 41-44) does not support her findings, because there is no showing that Orton, for example, which utilizes a single computer contains "two parties who do not trust each other". Therefore, she has failed to show motivation as required by controlling law. And again, the Examiner simply ignores her obligation to show reasonable likelihood of success, because of the readily apparent incompatibilities of Herman with both Chung and Orton.

Claim 2 depends from claim 1 and is further limited by "wherein said security facility further comprises an encryption object". The claim requires that the claimed "security

---

[2]Again, the Examiner does not distinguish between the "invention", which is defined by the claims, with the disclosure. However, because she cites only the disclosure, it is assumed that she actually means "disclosure".

facility", which performs the security functions, is itself "an encryption object", at least in part. Nevertheless, the Examiner ignores Applicant's claimed invention and cites Herman, column 18, lines 45-47, which states:

> This module is responsible for encryption and decryption of objects and other data, as well as creation of cryptography keys.

Apparently, the Examiner cannot distinguish between the claimed "encryption object" and the "object and other date" which is encrypted by Herman. The rejection of claim 2 is respectfully traversed.

Claim 3 depends from claim 2 and is further limited by "wherein said security facility further comprises security support provider interface". The alleged combination does not disclose this limitation. Therefore, the Examiner cites Orton, column 3, lines 50-53, which states:

> The present invention is directed to a system and method of enabling an object-oriented application to access in an object-oriented manner a procedural operating system having a **native procedural interface**. (Emphasis added)

It is not understood why one would consider this citation pertinent to Applicant's claimed invention unless the Examiner clearly erroneously alleges that the claimed "security support provider interface" is the same as the "native procedural interface" of Orton. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and is further limited by "wherein said security facility further comprises a decryption object". The claim requires that the claimed "security facility", which performs the security functions, is itself "a decryption object", at least in part. Therefore, the Examiner simply ignores Applicant's claimed invention and does not address it. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and is further limited by "wherein said user terminal is responsively coupled to a data base management system via a publically accessible digital data communication network and wherein said service application is located within said data base management system". As explained above, the alleged combination does not disclose the limitations of claim 4 from which claim 5 depends. Therefore, the alleged combination cannot disclose the further limitations of claim 5. The rejection of claim 5 is respectfully traversed.

The Examiner has refused to examine claim 21 in accordance with controlling law. Instead, she has stated:

> This claim has limitations that is (sic) similar to those of claims 1, 5, thus it is rejected with the same rationale application against claims 1-5 above.

As explained above, "limitations that is (sic) similar" is not a legally cognizable test. The rejection of claim 21 is respectfully traversed as not having been examined.

Having thus responded to each objection and ground of rejection, Applicant respectfully requests entry of this amendment and allowance of claims 1-21 being the only pending claims.

Respectfully submitted,

Lowell D. Palecek

By his attorney

Date Sept 8, 2008

Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, MN 55413
(612) 331-1464